

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Our Case No. 14829US02)**

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| In the Matter of: |) | |
| |) | <i>Electronically Filed on November 24, 2009</i> |
| Jeyhan Karaoguz, et al. |) | |
| |) | |
| Serial No. 10/672,907 |) | |
| |) | |
| Filed: September 26, 2003 |) | |
| |) | |
| For: THEFT PREVENTION OF |) | |
| MEDIA PERIPHERALS IN A MEDIA |) | |
| EXCHANGE NETWORK |) | |
| |) | |
| Examiner: Christopher A. Revak |) | |
| |) | |
| Group Art Unit: 2431 |) | |
| |) | |
| Confirmation No. 9187 |) | |

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Paper responds to the Examiner's Answer mailed October 2, 2009. For at least the reasons set forth in the June 19, 2009 Appeal Brief and below, the Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-25 of the present application.

REMARKS

The Examiner's Answer maintains the same rejections set forth in the December 3, 2008 Final Office Action. Indeed, the main argument set forth in the Examiner's Answer is essentially identical to that set forth in the Final Office Action. Compare October 2, 2009 Examiner's Answer at pages 3-12 with December 3, 2008 Office Action at pages 2-11. Accordingly, the Appeal Brief addresses these arguments at pages 6-11. To the extent that the Examiner's Answer raises new issues and arguments, the Applicants will address these below.

I. **The Proposed Combination Of Merriam In View Of Tsujisawa And Saito Does Not Render Claims 1-4 And 7-25 Unpatentable**

The "examiner disagrees with the Appellant's assertion" that the cited references fail to describe, teach or suggest "wherein said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered." See Examiner's Answer at pages 12-13 (emphasis added).

The Applicants reiterate that to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03 (emphasis added). Further, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." See *id.* (emphasis added).

Claim 1, for example, recites, in part, "wherein said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered." The claim clearly recites that the device serial number is associated with a location where the communication device is registered.

The Examiner's Answer acknowledges that the "combined teachings of Merriam and Tsujisawa fail to disclose of registration information associated with a device

serial ID number associated where the location [of] the communication device is registered.” See Examiner’s Answer at page 4.

In an attempt to overcome this deficiency, the Examiner’s Answer continues to rely on Saito. See *id.* at pages 4-5. In particular, the Office Action relies on Saito at **column 14, lines 49-67.**

As explained in the Appeal Brief, and as shown below, however, this portion of Saito does not describe, teach or suggest “at least one registration information comprises a device serial ID number associated with said location **where the communication device is registered,**” as recited in claim 1, for example. In particular, the cited portion of Saito discloses the following:

If the server 107 acquires the home address, as the IP address, of the responding terminal 102 from the DNS (Domain Name Server) 123, the server 107 **checks whether the device ID** of the mobile terminal corresponding to the acquired home address **is registered in the database 114** (FIG. 17). If the device ID of the mobile terminal is found in the database 114, the server 107 extracts, from the database 114, a current locator information serving as a location identifier corresponding to the device ID. The server 107 generates an IPv6 address of the responding terminal 102 by combining the extracted current locator as the higher-order 64-bit address and the lower-order 64 bits of the IP address received from the DNS (Domain Name Server) 123. The server 107 transmits the generated IPv6 address of the responding terminal 102 to the calling terminal 101. Thus, via the above process, on the calling terminal 101 can obtain in an efficient manner the address of the responding terminal 102, in which the current location of the responding terminal 102 is reflected.

See Saito at column 14, lines 49-67, which is the portion relied on by the Office Action (emphasis added). As shown above, the cited portion of Saito indicates that the server “checks whether the device ID ... is registered in the database.” There is no indication, however, that a device serial number is associated **with a location where the communication device is registered, or home location, etc.** Instead, it merely notes

that the server checks to determine **if** the device is registered, but not anything with respect to **where** it was registered.

Next, the cited portion of Saito clearly indicates "current locator information." "Current" means where the device actually is at that particular time, but not a previous time and/or where the device was actually registered.

Additionally, the Examiner's Answer now cites Saito at column 12, lines 8-11 and 29-48 as somehow disclosing "at least one registration information comprises a device serial ID number associated with said location **where the communication device is registered**," as recited in claim 1, for example. See Examiner's Answer at page 13. However, these portions merely indicate that the "server 107 acquires a globally unique identifier (ID) of a communication terminal on the basis of data received from the terminal." See Saito at column 12, lines 8-11. Further, the "server 107 also stores, in the database 114, information managed by the mapping agent ..., that is, movement information of mobile nodes." See *id.* at column 12, lines 28-34 (emphasis added). Also, this portion of Saito is, once again, focused on a "current locator map," but not the location where a device was registered. See *id.* at column 12, lines 34-44. Again, there is absolutely no mention of associating a device serial ID number with a location **where the device is registered**.

The Examiner's Answer states that "Tsujiisawa and Saito ... both disclose of registration of the location of the communication device. Saito shows that the location information is associated with a device ID." See Examiner's Answer at page 13. As explained in the Appeal Brief and above, however, Saito does not describe, teach or suggest associating the location where a device is actually registered (as opposed to where it "current" is) with a device ID.

As noted in the Appeal Brief and above, the Examiner's Answer acknowledges that the "combined teachings of Merriam and Tsujiisawa fail to disclose of registration information associated with a device serial ID number associated where the location [of] the communication device is registered." See Examiner's Answer at page 4 (emphasis added). Further, the portion of Saito that the Office Action relies upon to overcome this deficiency does not, in fact, describe, teach or suggest "wherein

said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered," as recited in claim 1, for example. Thus, by definition, none of the cited references, alone or in combination with one another, describes, teaches or suggests this limitation. That is, if none of the cited references describes, teaches or suggests the relevant limitations, the references together cannot somehow disclose a limitation that is nowhere to be found in any of the cited references. Therefore, the cited references do not describe, teach or suggest "all the claim limitations." Accordingly, the Examiner's Answer has not established a *prima facie* case of obviousness with respect to the claims. See, for example, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

For at least these reasons, and those set forth in the Appeal Brief, the Applicants respectfully submit that the Examiner's Answer has not established a *prima facie* case of unpatentability with respect to claim 1, or any of the claims that depend therefrom, including claims 5 and 6.

As explained above, the proposed combination of references does not describe, teach or suggest "a device serial ID number of the communication device associated with said location where the communication device is registered," as recited in claim 7. Thus, for at least these reasons, the proposed combination does not render claim 7 and the claims that depend therefrom unpatentable.

As explained above, the proposed combination of references does not describe, teach or suggest "the **registration information** associated with a **location of the communication device**, wherein said registration information comprises a **device serial ID number of the communication device associated with said location**," as recited in claim 9. Thus, for at least these reasons, the proposed combination does not render claim 9 and the claims that depend therefrom unpatentable.

As explained above, the proposed combination of references does not describe, teach or suggest "the registration information associated with at least the second home environment, wherein the **registration information comprises a device serial ID number of the media device associated with the second home environment**," as recited in claim 15. Thus, for at least these reasons, the proposed combination of

references does not render claim 15 and the claims that depend therefrom unpatentable.

II. The Proposed Combination Does Not Render Claims 22-25 Unpatentable For Additional Reasons

Claim 22 recites “wherein said registering comprises entering the device serial ID number of the communication device associated with said location where the communication device is registered **if the device is to be used only at said location where the communication device is registered**, and wherein said registering comprises entering the device serial ID number of the communication device, a user name and a password **if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.**” Claims 23-25 recite similar limitations.

The Applicants explain that the proposed combination of references does not render these claims unpatentable. See Appeal Brief at pages 10-11.

The Examiner’s Answer seems to stand for the proposition that the Applicants are arguing that the cited references do not disclose entering a serial device ID or a password. See Examiner’s Answer at pages 18-19.

However, the Examiner’s Answer oversimplifies the Applicant’s position. The Applicants respectfully submit that the Examiner’s Answer has not shown where the cited references describe, teach or suggest “wherein said registering comprises **entering the device serial ID number** of the communication device associated with said location where the communication device is registered **if the device is to be used only at said location where the communication device is registered**, and wherein said registering comprises entering the **[1] device serial ID number** of the communication device, **[2] a user name and [3] a password if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.**” The claims are clear that the registering includes entering the device serial ID number if the device is to be used only as the location where it was registered, and entering (1) the device serial ID number, (2) a user name, and (3) a password if the device is to be used at another

location other than where it was registered. The Examiner's Answer does not explain where the cited references describe, teach or suggest such limitations. Indeed, the Examiner's Answer seems to completely disregard the "if" and "only" clauses of the claim, as none of the cited portions of the references disclose these limitations.

Thus, for at least these additional reasons, the proposed combination of references does not render claims 22-25 unpatentable.

III. CONCLUSION

For at least the reasons discussed in the Appeal Brief and above, the Applicants respectfully submit that the pending claims are in condition for allowance. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-25.

IV. PAYMENT OF FEES

The Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: November 24, 2009

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